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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,516	03/01/2002	Cliff Roth	GIST-005/01US	4083
22903	7590	11/09/2004	EXAMINER	
COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/087,516		ROTH ET AL.	
	Examiner		Art Unit	
	Etienne P LeRoux		2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Status of the Claims

Claims 1-27 are pending. Claims 1-27 are rejected.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System and method for generating a recommendation guide for use with an Electronic Program Guide

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "generating a list of displayable program indicators." The specification does not contain a description of the process of making a list of displayable program indicators such that a skilled artisan can make and use the invention. The process of excluding restricted

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programs while including programs from the preferred and recommended categories is not considered in the specification.

Claim 1 recites “wherein the displayed program indicators are arranged according to the retrieved category preferences.” The process of electronically assigning a program to a user defined preference category is not mentioned in the specification. The specification does not describe how programs are automatically selected to match one of a plurality user defined preference categories. In particular, the specification does not contain a description of the process whereby a user is able to categorize programs received from the service provider such a program received from the service provider can be automatically allocated to a user’s preference category.

Claims 5 and 19 include language similar to claim 1 and are thus rejected for reasons similar to claim 1.

Claims 2-4, 6-18 and 20-27 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “retrieving a list of preferred program indicators; retrieving a list of recommended program indicators, the program indicators included in the list of recommended program indicators corresponding to at least one of the retrieved category preferences.” The

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scope of the invention is difficult to ascertain because it is unclear what difference, if any exists between preferred program indicators and recommended program indicators. For the purposes of this office action, examiner will assume that no difference exists between preferred program indicators and recommended program indicators.

Claim 1 recites “generating a list of displayable program indicators, wherein the list of displayable program indicators includes program indicators included in the list of preferred program indicators and program indicators included in the list of recommended program indicators but not included in the list of restricted program indicators.” The scope of the invention cannot be determined as it is difficult to determine if some or all of the programs from the preferred programs and recommended programs are selected to be displayed.

Claim 3 recites “wherein the restricted program indicators correspond to program indicators included in the list of recommended program indicators.” The scope of the invention cannot be determined because it is difficult to determine how a program indicator can simultaneously be restricted and recommended.

Claim 4 recites “wherein at least one of the program indicators included in the list of preferred program indicators is not included in the list of recommended programs.” The scope of the invention cannot be determined because the difference, if any, between a preferred program and a recommended is not clear.

Claims 5 and 19 include language similar to claim 1 and are thus rejected for reasons similar to claim 1.

Claims 2, 6-18 and 20-27 are rejected for being dependent from a rejected base claim.

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Art Rejection Precluded

Claims 3 and 4 are rejected under 35 U.S.C. 112, first and second paragraphs, as being indefinite and lacking enablement. No art rejection of claims 3 and 4 is provided in this office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8 and 10-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,781,246 issued to Alten et al (hereafter Alten), as best examiner is able to ascertain.

Claims 1, 5 and 19:

Alten discloses a method for generating an electronic program listing recommendation guide [abstract], the method comprising:

- receiving a request from a user to generate a recommendation guide [col 26, lines 35-43];
- retrieving category preferences associated with the user [movies, news, sports or children's shows, Fig 8, 83, col 26, lines 34-43];
- retrieving a list of restricted program indicators [parental guidance 301, Fig 30, col 20, lines 9-33];

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- retrieving a list of preferred program indicators [viewer preference mode 161, Fig 16, col 19, lines 49-57];
- retrieving a list of recommended program indicators [favorite channel 71, Fig 7], the program indicators included in the list of recommended program indicators corresponding to at least one of the retrieved category preferences;
- generating a list of displayable program indicators [Fig 19, col 16, lines 52-67], wherein the list of displayable program indicators includes program indicators included in the list of preferred program indicators and program indicators included in the list of recommended program indicators but not included in the list of restricted program indicators [key lock, col 20, lines 16-23];
- displaying program indicators [Fig 19, col 16, lines 52-67] included in the generated list of displayable program indicators, wherein the displayed program indicators are arranged according to the retrieved category preferences.

Claim 2:

Alten discloses transmitting the generated list of displayable program indicators to a set-top box associated with the user [col 7, lines 30-40].

Claim 6:

Alten discloses displaying the retrieved program data for a first program indicator included in the list of displayable program indicators, wherein the retrieved program data for the first program indicator is displayed in association with a first category included in the plurality of

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category preferences, wherein the first category corresponds with the first program indicator [Fig 19, col 20, lines 52-67].

Claim 7:

Alten discloses displaying the retrieved program data for a second program indicator included in the list of displayable program indicators, wherein the retrieved program data for the second program indicator is displayed in association with a first category included in the plurality of category preferences, wherein the second category corresponds with the second program indicator [Fig 19, col 20, lines 52-67].

Claim 8:

Alten discloses displaying the first program indicator and an indicator of the first category in a first column; and displaying the second program indicator and an indicator of the second category in a second column [Fig 19].

Claims 10 and 20:

Alten discloses wherein the list of displayable program indicators comprises a list of recommended programs [Fig 18].

Claims 11 and 21:

Alten discloses receiving the list of recommended programs from a remote source [Fig 18].

Claims 12 and 22:

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Alten discloses identifying a restricted program indicator, the restricted program indicator being selectable by the user; wherein the list of displayable program indicators does not include the restricted program indicator [key lock, col 20, lines 16-23].

Claims 13 and 23:

Alten discloses removing the restricted program indicator from the list of displayable programs [col 20, lines 41-45].

Claims 14 and 24:

Alten discloses identifying a preferred program indicator, the preferred program indicator being selectable by the user, wherein the list of displayable program indicators includes the preferred program indicator [viewer preference mode 161, Fig 16, col 19, lines 49-57].

Claims 15 and 25:

Alten discloses adding the preferred program indicator to the list of displayable programs indicators [viewer preference mode 161, Fig 16, col 19, lines 49-57].

Claims 16 and 26:

Alten discloses identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and removing the target program indicator from the list of displayable program indicators [col 26, lines 33-34].

Claims 17 and 27:

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Alten discloses identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and assigning a low display priority to the target program indicator included in list of displayable program indicators [revise schedule, col 19, lines 49-57].

Claim 18:

Alten discloses wherein the plurality of category preferences are customizable by the user [revise schedule, col 19, lines 49-57].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alten, as best examiner is able to ascertain..

Claim 9:

Alten discloses the elements of claims 5-7 as noted above.

Alten fails to disclose displaying the first program indicator and an indicator of the first category in a first row; and displaying the second program indicator and an indicator of the second category in a second row. It is noted that displaying the first program indicator and an indicator of the first category in a first row; and displaying the second program indicator and an indicator of the second category in a second row is well-known and expected in the art because a user typically finds it easy to read from top to bottom. The skilled artisan would have been motivated to modify the invention of Alten per the above such that data can be presented in a art recognized database format.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pub No US 2003/0118323 discloses a user preference determination module which categorizes television programs viewed by the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

November 2, 2004



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100